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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,650	09/24/2003	Michiya Katou	50046-00004	9502

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EXAMINER	
ELLINGTON, ALANDRA	

ART UNIT	PAPER NUMBER
2855	

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

AK

Office Action Summary	**Application No.** 10/677,650	**Applicant(s)** KATOU, MICHIYA	
	Examiner Alandra Ellington	**Art Unit** 2855	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/24/03,1/13/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 9,10, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Prenninger (US 2004/0021562).

a. With respect to Claim 9, Prenninger discloses a tire condition monitoring method comprising a first step including a condition detecting step for detecting the condition of each tire 2, and an acceleration detecting step for detecting the direction of acceleration accompanying rotation of the corresponding tire 2, wherein data containing data representing the detected condition of the tire 2 and data representing the detected direction of the acceleration is wirelessly transmitted (pg. 3 [0042,0047,0049]; and a second step, wherein, when the data of the first step is received, the position of the tire 2 is determined based on the level of a signal related to the received data (pg. 3 [0049], pg. 4 [0050-0051]).

b. With respect to Claim 10, Prenninger discloses the tire condition monitoring method according to claim 9, further comprising a step in which, when the data of the first step is received, information of the position of the tire 2 is stored based on the level of a signal related to the received data (pg. 4 [0053-0055]).

c. With respect to Claim 12, Prenninger discloses the tire condition monitoring method according to claim 9, wherein, in second step, whether the data corresponds to one of the left tires or to one of the right tires is determined based on the data representing the direction of the acceleration, and, whether the data corresponds to one of the front tires or to one of the rear tires is determined based on the level of a signal related to the data (pg. 4 [0056-0061], pg. 5 [0066-0067,0071-0073]).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Normann et al (US 2002/0113692) (hereinafter Normann) in view of Prenninger (US 2004/0021562).

a. With respect to Claim 1, Normann discloses a tire condition monitoring apparatus with a plurality of transmitters 3, each of which is provided in one of the tires 1, wherein each transmitter 3 includes a condition detecting device for detecting the condition of the corresponding tire 1; a first reception antenna 6 provided in the vehicle to correspond to the left and right front tires 1, wherein the first reception antenna 6 receives data from the transmitters 3 of the left and right front tires 1; a second reception antenna 7 provided in the vehicle 2 to correspond to the left and right rear tires 1, wherein the second reception antenna 7 receives data from the transmitters 3 of the left and right rear tires 1; and a receiver 9 that receives data from the transmitters 3, wherein, when receiving data from one of the transmitters 3, the receiver 9 determines the position of the tire 1 in which the transmitter 3 that is the source of the data is provided based on the levels of received signals each sent from the first reception antenna 6 and the second reception antenna 7 (pg. 5 [0051,0053], pg. 6 [0057-0058] {Figs. 1,3}). However, Normann does not teach an acceleration detecting device for detecting the direction of acceleration accompanying rotation of the corresponding tire, wherein each transmitter wirelessly transmits data containing data representing the condition of the tire detected by the condition detecting device and data representing the direction of the acceleration detecting device. Prenninger teaches an acceleration detecting device 17 for detecting the direction acceleration accompanying rotation of the corresponding tire 2, wherein each transmitter 3 wirelessly transmits data containing data representing the condition of the tire detected by the condition detecting device and data representing the direction of the acceleration detecting device 17 (pg. 3 [0047,0049], pg. 4 [0050] {Figs. 1,2}). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Normann with the teachings of Prenninger to include an acceleration detecting device for the purpose of measuring the rotation or speed if the wheel in order to accurately determine the condition of each tire (see Prenninger, pg. 2 [0028], pg. 3 [0047,0049], pg. 4 [0050]).

b. With respect to Claim 2, Prenninger teaches a receiver 6 that determines the rotation directions of the tires 2 based on a speed and a moving direction of the vehicle (pg. 3 [0039-0041] {Figs. 1,3}).

c. With respect to Claim 3, Normann discloses a receiver 9 that stores information of the position of the tire 1 in which the transmitter 3 is provided based on the levels of received signals each sent from the first reception antenna 6 and the second reception antenna 7 (pg. 5 [0052], pg. 6 [0058]).

d. With respect to Claim 8, Normann discloses a receiver 9 with a notifying device 17 for notifying a passenger of the positions and the conditions of the tires 1 (pg. 6 [0057-0058] {Fig. 2}).

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Normann (US 2002/0113692) in view of Prenninger (US 2004/0021562) as applied to claim 1 above, and further in view of Schofield et al (6,731,205) (hereinafter Schofield).

a. With respect to Claim 6, Normann discloses a plurality of transmitters 3, each of which are provided in one of the tires 1, wherein each transmitter 3 includes a condition detecting device for detecting the condition of the corresponding tire 1; a first reception antenna 6 provided in the vehicle 2 to correspond to the left and right front tires 1, wherein the first reception antenna 6 receives data from the transmitters 3 of the left and right front tires 1; a second reception antenna 7 provided in the vehicle 2 to correspond to the left and right rear tires 1, wherein the second reception antenna 7 receives data from the transmitters 3 of the left and right rear tires 1; and a receiver 9 that receives data from the transmitters 3, wherein, when receiving data from one of the transmitters 3, the receiver 9 determines the position of the tire 1 in which the transmitter 3 that is the source of the data is provided based on the levels of received signals each sent from the first reception antenna 6 and the second reception antenna 7 (pg. 5 [0051,0053], pg. 6 [0057-0058] {Figs. 1,3}). Prenninger discloses an acceleration detecting device 17 for detecting the direction of acceleration accompanying rotation of the corresponding tire 2, wherein each transmitter 3 wirelessly transmits data containing data representing the condition of the tire detected by the condition detecting device and data representing the direction of the acceleration detected by the acceleration detecting device 17 (pg. 3 [0047,0049], pg. 4 [0050] {Figs. 1,2}). However, Normann in view of Prenninger does not teach a shift lever. Schofield teaches the moving direction of the vehicle being based on a signal representing a position of a shift lever (col. 9 lines 3-12, col. 16 lines 16-20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Normann in view of Prenninger with the teachings of Schofield to include a shift lever for the purpose of comparing measured pressures in order to determine the associated tire position (see Schofield, col. 9 lines 3-12, col. 16 lines 16-20).

Double Patenting

Statutory 35 U.S.C. 101

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 1-12 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-18 of prior U.S. Patent No. 6,705,155. This is a double patenting rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(6,304,172) (6,794,993) (3,796,990) (3,806,869) (3,873,965) (6,774,777)

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alandra Ellington whose telephone number is (571) 272-2178. The examiner can normally be reached on Monday - Friday, 7:30am - 4:00pm.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Lefkowitz can be reached on (571) 272-2180. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER